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Nos. 9875, 9876, 9903

Supreme Court of the United States

OCTOBER TERM No. 546 - 548

No. 9875

LUCY B. O'LEARY and THE ROTOR CLOCK
COMPANY,

Petitioners,

v.

THE LIGGETT DRUG COMPANY,

Respondent.

No. 9876

LUCY B. O'LEARY and THE ROTOR CLOCK
COMPANY,

Petitioners,

v.

SEARS, ROEBUCK & COMPANY,

Respondent.

No. 9903

LUCY B. O'LEARY and THE ROTOR CLOCK
COMPANY,

Petitioners,

v.

THE JOHNSTON-SHELTON CO., a corporation
of Ohio, d. b. a. THE HOME STORE,

Respondents.

**PETITION FOR WRIT OF CERTIORARI AND BRIEF
IN SUPPORT THEREOF**

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PETITION FOR WRIT OF CERTIORARI

To the Circuit Court of Appeals for the Sixth Circuit

*To the Honorable Chief Justice of the United States,
and the Associate Justices of the Supreme Court of
the United States:*

Your petitioners, Lucy B. O'Leary and the Rotor Clock
Company, pray for a writ of certiorari to the Circuit Court
of Appeals for the Sixth Circuit, to review the judgments

of that Court entered July 26, 1945. There are three cases involved, tried together and decided together. Your petitioners were required by the parties defendant below, to file two records in the Court of Appeals. A transcript of the record in each case including the proceeding in the Court of Appeals is furnished herewith in accordance with the rules of this Court. The records are almost identical, and references hereafter will be to the record in Appeals Nos. 9875 and 9876.

STATEMENT

1. This cause is a regular patent infringement suit brought by Petitioners, plaintiffs and appellants below, on patent No. 1,971,793 against a series of defendants, who constitute the chief manufacturers of low price electric clocks in this country, through suits against dealers, whose places were taken by the manufacturers at the trial. They were Hammond Instrument Co., Westelox Division of The General Instrument Co., E. Ingraham Co., and the Gilbert Clock Co.

2. Both the District Court and the Court of Appeals made findings which are in agreement to the effect that although the patented device was one of extreme simplicity over the prior art, the novelty inherent in this simplicity of structure exhibited only mechanical skill over the art. Both Courts refused to take into consideration the commercial history of the invention, in coming to this conclusion, relying instead on expert testimony.

3. Both Courts recognized that the Patent Office Board of Appeals, on an issue substantially identical with the issue presented to them as to mere mechanical skill, held that "there is invention in this radical simplification of the device." Except for one cited type of prior art patented structure of major complexity, the same patents before the Board of Appeals of the Patent Office were before the

Courts, yet the opposite conclusion was drawn therefrom. Thus the conclusion on the point of mechanical skill versus invention could not be free from doubt.

4. The O'Leary invention was shown on the record to have been made by a man of limited means at Dayton, Ohio, working with his sons in a small shop. Soon after his invention was prepared he started to try to obtain licensees under it, and just before the Depression, obtained a promising licensee. This licensee failed in 1929 and 1930. The invention was brought to the attention of other manufacturers. Many of them started to negotiate for licenses. Then they started to defy O'Leary, twitting him with lack of means to protect himself, but in the meantime putting his invention to use. There ensued a long struggle with poverty. The father died. His sons, one of whom could get no job but driving a trolley bus, and the other of whom was married and working as a teacher, stimulated perhaps by a desire to vindicate their father, vainly endeavored to get respect for their patent through licenses. Once or twice it appeared as if help could be obtained to prosecute infringers; but when it appeared that the industry would gang up on the O'Learys, this help faded away. Finally friends in their home town offered financial help to bring one action, and the suits in question here were brought. Against the O'Learys was arrayed the technical and legal talent of practically the entire small motor art. As of the date the suit was brought none of the prior art motors designed for uses to which the O'Leary motor was devoted were being used. Everyone was using the O'Leary motor (Rec. pp. 169 through 209).

5. It was old to make a motor by using a toothed rotary disk and a single magnet pole, and old to make a motor with a toothed disk and two magnet poles, opposite in polarity to each other; but wherever it was attempted to multiply the power by multiplying the magnet teeth in a

motor using a toothed disk rotor, it had been the practice to set up a series of magnets, or place windings on the teeth of the toothed disk or place numerous windings or coils on the magnet. The art apparently saw no other way of permitting the use of a series of magnet poles to cooperate with the series of teeth on the disk. What O'Leary did was to make up a motor with only a *single* magnet with *two* poles but he cut these into a *series of teeth*. He used a rotary toothed disk without any windings on the teeth, and placed no windings on the magnet teeth. This gave O'Leary the power resulting from a series of magnets pulling on the teeth of the rotary member, yet saved at one sweep all of the complications of the past. The effect of the arrangements in prior motors was to give impulses to the rotary disk which were more or less tangential to the disk. The effect in O'Leary was to give impulses which were reciprocatory and would seemingly hold the rotary disk in a fixed position, not cause it to move (Court of App. Decision p. 4).

6. It was possible for experts to take models of the motors of the prior art and pull away the windings, incidentally leaving the slots in place which were used for the location of the windings, and make a motor responding more or less roughly to the O'Leary motor, or to pull away a magnet and cut teeth in the remaining one and again produce an O'Leary motor out of a prior art motor. They demonstrated this in Court. It was possible for the experts for the grouped defendants to figure out a generalization which brought the O'Leary mode of operation and the prior art motors into single class. Cryptic language in a book by Steinmetz, flashed on plaintiffs below at the trial, was relied upon to support this generalization (Rec. 260, 340). Yet in the patent on one of the two motors referred to above (Holtz) it was said that the winding on the pole teeth gave a "rotating field" to the motor, and it was said in effect in the other of the two patents (Coerper) that

because the rotating disk *retained* its magnetism, it was not possible to do what O'Leary did (See Appended Brief for References).

7. Both the District Court and the Court of Appeals on those facts held that the reason for the winding on the Holtz motor was to make it self-starting (not the reason given in the patent), and that the reasoning given in the Coerper patent as to the requirements of a pair of magnets was a mistake on the part of the patentee and would not mean that the O'Leary construction would be impractical, (directly contrary to what the Coerper patent stated). They further both held that *those skilled in the art would know that the changes over the Holtz and the Coerper patents could be made* with the results which O'Leary obtained, a fact which they concluded largely from the demonstrations by experts in Court above referred to.

8. It is deemed most significant that in the face of a decision of the Board of Appeals in the Patent Office this stripping away and revamping to extreme simplicity was inventive in nature, and in the face of the fact that it was necessary in their determination for the Courts to say *what those skilled in the art would know*, it was nevertheless concluded that there was no necessity for considering the commercial history of the invention, to determine whether or not it would prove what those skilled in the art *did* know as against what highly paid *experts* said they *would know*.

9. The point made by the plaintiff respondent below, and on appeal to the Court of Appeals, was that the commercial history should have been considered, because it was not possible in view of the circumstances, to state that lack of invention was free from doubt. If the commercial history had been considered, it would have been completely definite that far from the change to inexpensiveness and simplicity being obvious, the art had gone on for years, ad-

hering to principles in their multi-toothed small motors which required various appurtenances to their structures, but as soon as the O'Leary motor was brought to their attention, shifted to its construction. But O'Leary was poor. He and his sons faced by the Depression were deprived of any chance against the huge aggregation of capital which had concluded to pass them by. The O'Learys did not succeed financially, but the rest of the art did. We maintained below that under such circumstances, it could not be true that the extreme simplification of electric motors brought into the art by O'Leary was nothing but mechanical skill.

10. The Court of Appeals in its decision indicates clearly that the authorities in the past on the subject of when the simplification of a device is inventive, are not any longer applicable. Furthermore, in considering the problem of whether what O'Leary did was simply to remove devices from prior motors with the result of eliminating their function, both Courts below considered that it was proven that this was all that O'Leary did, because when the prior motors were in fact stripped they would still operate, but without operative features that they had had prior to the removal. This was obviously illogical since the motors with the former structural complexity were stated in the patents which disclosed them to operate on theories which were not followed by the O'Leary motor. The so-called tests simply proved that O'Leary was correct in his patent, *not* that the prior art *knew* that this would be true, which is the key question.

11. It was urged that in connection with an invention which consists in simplifying prior devices, it was bound to be true that the competitive industrial art was interested in finding ways of accomplishing this. Hence an effort over the years to simplify small motors and still get sufficient power in them would be presumed. To fail to consider what

the art had actually done when the O'Leary invention was brought to their attention thus neglects, under the particular circumstances, the prime essential fact upon which inventiveness as against non-inventiveness can be determined.

12. In the preparation for filing of these present suits, there were collected the non-self-starting clocks which could be found and the ones selected for suit were the principal makers of such clocks. The money obtained for these suits from personal friends has been spent and they do not feel warranted in spending any more. In connection with this petition for certiorari, the plaintiffs were able to save up \$400.00 which they have paid to counsel to cover preliminary printing and filing charges and counsel have agreed that they will proceed through petition for certiorari giving time to the plaintiffs to pay up the attorney fees. What this means is that it is utterly out of the question for plaintiffs to file any other suits against users of the O'Leary invention in non-self-starting synchronous motors. Thus this petition for certiorari is the only possible route whereby the plaintiffs may present their last chance at a consideration of their patent. An affidavit to the essential facts is herewith presented (It is printed in the Appendix herewith).

QUESTIONS PRESENTED

1. The principle, in a case where the invention is one of patentable novelty by virtue of simplicity, and the Patent Office Appellate tribunal has held that the simplicity was in fact inventive, that there is still no necessity of considering the historical results of the impact of the invention on the existing art, is wrong and should be correctly concluded by this Court, because there must be a reasonable doubt under such circumstances as to patentable novelty.

2. Where an inventor takes the standard practice in an industry which is old and well established and radically

simplifies the existing structures, and the industry changes over to the simplified form after direct approach by the patentee, this is not a matter of "commercial success" but is instead a fact which must be considered in determining whether or not the art knew that the indicated simplification was possible; and the applicable decisions which state that commercial success will not change the conclusion on the question of patentable invention unless doubtful, do not apply. It is not believed that this question has been heretofore presented to this Court, and that this Court should pass upon the same.

3. Where an inventor first discovers that an effective electric motor can be made with only two poles divided up into teeth, with no windings on the poles of the magnet and no windings on the poles of a toothed rotary member, and this requires a species of electrical behavior not theretofore put into play in electric motors, it is no answer to the contention of inventive novelty to show that prior motors could be stripped of pole windings on the stator and pole windings on the rotor and thereby made into an approximation of the patented motor. No conclusion by the Court of Appeals which embraces such a proposition as determinative of inventive novelty, should be permitted to stand.

4. While it is recognized as a rule of this Court that it will not accept a case where a determinative fact has been found alike both by the District Court and the Court of Appeals (in this case that only mechanical skill was involved as distinguished from inventive novelty), yet where this determinative fact is a deduction drawn from facts which are also found and which are not disputed or are set forth in printed documents and there was an admitted failure to consider an important fact having direct bearing on the issue (viz., the behavior of the art as indicating what they knew and did not know to be possible), the

Supreme Court is warranted in reviewing the facts in order to determine whether or not the said conclusion of the Courts below would be considered as decisive, and either sending the case back for such consideration or reaching its own conclusion, based thereon.

REASONS FOR GRANTING THE WRIT

1. Certiorari to the Supreme Court is the only route within the means of the Petitioners (plaintiffs below) to obtain an adjudication favorable to their patent, for the reason that the principal infringers in the clock field were sued in the present litigations, and there are no funds available to bring any further suits, particularly with the requirements for experts and technical testimony which the records of the present suits will require in order to avoid the weight of the present decisions against the patent. *Schriber Schroth Company v. The Cleveland Trust Co.*, 305 U. S. 47.

2. The matters involved here are of great public interest because this is a period where expansion of our economy is essential, and the devotion of effort toward inventions is dampened in our people by each decision which departs further from their intuitive beliefs as to what is an invention, and because the questions presented as set forth above deal with a subject which has not been studied by this Court since *Lawther v. Hamilton*, 124 U. S. 1, which in reasoning and application is in effect overruled by the Court of Appeals.

LUCY B. O'LEARY and
THE ROTOR CLOCK COMPANY.
By MARSTON ALLEN,
Attorney for Petitioners.